

REMARKS

The indication in the outstanding Office Action that claims 30 and 32 are allowed is appreciated. In view of the following comments, it is believed that the remaining claims are also allowable.

The outstanding Office Action includes a rejection of claim 31 under 35 U.S.C. § 112, first paragraph. This rejection is traversed.

It is understood that the basis for rejecting claim 31 is that the "specification does not enable a polydiorganosiloxane polyurea copolymer used as a primer and containing a silicate tackifying resin." It is pointed out that claim 31 provides that "the primer further includes a silicone tackifying resin." The specification does, in fact, enable a primer containing a polydiorganosiloxane polyurea copolymer and a silicone tackifying resin. The Examiner's attention is directed to the specification at page 2, lines 21-23, disclosing an embodiment where "the priming composition further includes a silicone tackifying resin." The preceding sentence in the specification at page 2, lines 19-21, provides that the priming composition includes polydiorganosiloxane polyurea copolymer. Furthermore, the specification at page 12, lines 2-12, describes how one selects that amount of silicone tackifying resin relative to the polydiorganosiloxane polyurea copolymer to control the glassy to rubbery transition of the polydiorganosiloxane polyurea copolymer. In addition, it is pointed out that claim 31 is part of the original disclosure and enables a primer including both a polydiorganosiloxane polyurea copolymer and a silicone tackifying resin. Accordingly, the specification clearly enables a primer containing a polydiorganosiloxane polyurea copolymer and a silicone tackifying resin according to claim 31.

In view of the above comments, withdrawal of the rejection under 35 U.S.C. § 112, first paragraph, is requested.

The outstanding Office Action includes two prior art-based rejections. Claims 1-6, 8-14, 16-26, 29, and 33-38 stand rejected under 35 U.S.C. § 102(b) over EP 380 236 (Leir). Claims 7, 15, 27, and 28 stand rejected under 35 U.S.C. § 103(a) over Leir. These rejections are traversed.

Leir fails to disclose a priming composition comprising a polydiorganosiloxane polyurea copolymer comprising electron rich groups, wherein the electron rich groups are groups that provide self-priming capability. The Examiner's attention is directed at the specification of the above-identified patent application at page 2, lines 7-14. The specification describes what is meant by self-priming capability. In general, this means that there is no need for a secondary primer to adhere the composition of the present invention. Leir is not concerned with providing a composition that possesses self-priming properties.

The outstanding Office Action is somewhat confusing in its reliance upon U.S. Patent No. 5,106,951. According to the Office Action, U.S. Patent No. 5,106,951 is relied upon "as providing examples of electron rich groups." Although the Office Action does not reject the claims over U.S. Patent No. 5,106,951, it appears that the Office Action nevertheless refers to U.S. Patent No. 5,106,951 in order to assert the prior art-based rejections. The Examiner is requested to clarify whether she is relying upon U.S. Patent No. 5,106,951 for rejecting the claims.

The Office Action refers to U.S. Patent No. 5,106,951 at column 6, lines 48-53, for disclosing that electron rich groups can "include carboxylates and groups containing heteroatoms with unshared pairs of electrons such as oxygen and nitrogen." This disclosure by U.S. Patent No. 5,106, 951 is not particularly relevant since independent claims 1, 25, and 37 more clearly characterize the polydiorganosiloxane polyurea copolymer as comprising electron rich groups wherein the electron rich groups are groups that provide self-priming capability. U.S. Patent No. 5,106,951 is unconcerned with providing groups that provide self-priming capability.

Leir describes block copolymers having repeating units comprised of polysiloxane and urea segments that are prepared by copolymerizing diaminopolysiloxanes with diisocyanates.

It is submitted that Leir fails to disclose or suggest providing a priming composition comprising a polydiorganosiloxane polyurea copolymer comprising electron rich groups, wherein the electron rich groups are groups that provide self-priming capability. Furthermore, the outstanding Office Action fails to explain why one skilled in the art would modify Leir to provide electron rich groups that provide self-priming properties.

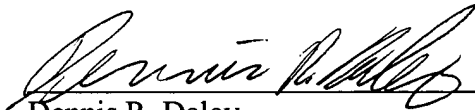
In view of the above comments, withdrawal of the rejections over Leir is requested.

It is believed that this application is in condition for allowance. Early notice to the effect is earnestly solicited.

Respectfully submitted,

MERCHANT & GOULD P.C.
P.O. Box 2903
Minneapolis, Minnesota 55402-0903
(612) 332-5300

Date: April 29, 2004


Dennis R. Daley
Reg. No. 34,994
DRD:jjb